



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,685	03/14/2002	Daniel R. Potter	005127.00033	4915

22909 7590 02/20/2004

BANNER & WITCOFF, LTD.
1001 G STREET, N.W.
WASHINGTON, DC 20001-4597

EXAMINER

RUDY, ANDREW J

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,685

Applicant(s)

POTTER ET AL.

Examiner

Andrew Joseph Rudy

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9 & 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's Request for Reconsideration has been reviewed and is convincing. The previous rejection regarding White et al., US 5,339,252, from Paper No. 6 is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, line 4, the phrase "one or more pieces of footwear in a variety of sizes" is not clear. How does one piece contain a variety of sizes?

Claim 10, line 5, the phrase "the interior" lacks antecedent basis and is not clear.

Claim 10, line 6, the phrase "that piece" (both instances) is not clear what is being referenced.

Claim 10, line 8, the phrase "for remolding lengths and widths of pieces of footwear" is not clear. Applicant's claim language requires only one piece of footwear, yet plural pieces are recited from this phrase. The Examiner is not clear as to Applicant's claim language.

Claim 11, line 4, the phrase “some of the pieces of footwear” is not clear as what footwear is being referenced.

Claim 11, line 5-6, the phrase “some of the pieces of footwear” is not clear as what footwear is being referenced.

The Examiner regrets that this rejection was not previously put forward to Applicant in order for more compact prosecution of Applicant’s inventive concept.

Claim Rejections - 35 USC § 103

4. Claims 10 and 11, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter, US 5,714,098, in view of Kelly, Jr., 5,783,810.

Potter discloses a shoe footwear inventory 9 containing a variety of sizes, a manufacturing unit 13 that may be located at a regional warehouse, e.g. a shoe distribution center and an order receiving unit that receives orders from retail stores, and a plurality of lasts in storage 15. Potter does not specifically disclose the term shoe distribution center.

Kelly discloses the common knowledge shoe distribution centers for receiving orders from retail stores.

To have provided a shoe distribution centers for receiving orders from retail stores for Potter would have been obvious to one of ordinary skill in the art in view of Kelly. The motivation for doing such is to provide common knowledge and well known distribution centers for receiving orders from retail stores for custom fit footwear associated with last size.

4. Claims 12-14, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter, US 5,714,098, in view of Kelly, Jr., 5,783,810, and further in view of White et al., US 5,339,252.

White discloses an electronic network system for last manufacturing for custom fitting footwear where a central storage facility last database 116 stores the particular sizing information used for producing a last where pieces of footwear in inventory are molded to lengths and shapes that are different from the original shape of the inventory (col. 3, lines 28-68, col. 10, lines 46-65) and footwear database 104 containing customer records for trend analysis 106. To have provided Potter in view of Kelly, an electronic communication network containing customer records for trend analysis would have been obvious to one of ordinary skill in the art in view of White. The motivation for doing such would be tracking of common knowledge customer history data. To have associated a last with such data would have been an obvious variant for one of ordinary skill in the art. The motivation for doing such would be to keep track of one variant of the customer history data.

5. Applicant's Information Disclosure Statement (IDS) have been received on October 29, 2003 and December 9, 2003 (a duplicate of the 10/29/03 IDS). Note attached IDS PTO-1449 from 12/9/03.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Andrew Joseph Rudy". The signature is written in a cursive, flowing style with a large initial "A" and "R".